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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,817	08/06/2003	Jordan William Hall	CL/V-32582A	9767
31781	7590	08/02/2005	EXAMINER	
CIBA VISION CORPORATION PATENT DEPARTMENT 11460 JOHNS CREEK PARKWAY DULUTH, GA 30097-1556				SCHWARTZ, JORDAN MARC
		ART UNIT		PAPER NUMBER
		2873		

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/635,817	HALL ET AL. <i>PM</i>
	Examiner	Art Unit
	Jordan M. Schwartz	2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 May 2005.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-48 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-14 and 16-48 is/are rejected.

7) Claim(s) 15 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/21/05.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

Claims 3, 19, 21, and 35-36 (and dependent claims 4-12, 20, 22-34 and 37-48) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 3, 19, 21, 35, and 36, claiming "reaching a maximum value at a position between the central optical zone and the upper edge of the edge zone and then decreases to the bottom edge of the edge zone" presents prohibited new matter. Specifically, from what is described in the specification, and apparently from what is shown in the Figures, the thickness increase and decrease does not occur through the edge zone. Therefore claiming decreasing to the bottom edge of the edge zone is not supported by the specification and Figures since it requires a thickness decrease through the edge zone. For purposes of examination the assumed meaning is as set forth in claim 1 as recently amended i.e. "reaching a maximum value at a position between the central optical zone and the edge zone and then decreases to the upper edge of the edge zone".

***Claim Objections***

Claim 1 is objected to because of the following informalities: in line 8, "transitional non-optical" should be corrected to "transitional non-optical zone". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 13-14, 16, 18-19, 26-27, 29-32, 35, 41-42, 44-46 and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Bronstein patent number 4,525,043.

Bronstein reads on these claims by disclosing the limitations therein including the following: a contact lens comprising a posterior and anterior surface (abstract, Figures 1-2); the anterior surface including a central optical zone (Figure 2, "36", column 4, line 21); a transitional non-optical zone extending from the central optical zone and surrounding the central optical zone (Figures 1-2, the inner portion of "38"); a peripheral zone surrounding the transitional non-optical zone (Figure 2, the outer portion of "38"); an edge zone circumscribing and tangent to the peripheral zone (Figure 2, "40"). The lens will inherently have a vertical and horizontal meridian since these are defined in the specification in terms of imaginary lines on the contact lens (page 6 of the specification). Bronstein further discloses the transitional non-optical zone has a surface which

provides a continuous transition from the central optical zone to the peripheral optical zone (Figure 1) to ensure that the peripheral zone, the transitional non-optical zone, and the central optical zone are tangent to each other (Figure 1); the peripheral zone having a thickness profile characterized by a mirror symmetry with respect to a plane cutting through the vertical meridian (Figure 1); a substantially constant thickness in a region around the horizontal meridian (Figure 1 i.e. a substantially constant thickness near the center of the lens); and a thickness which decreases progressively from the horizontal meridian upward to the bottom edge of the edge zone (Figure 1 which disclose the thickness progressively decreasing both upward and downward). The area of the peripheral zone is inherently equal to or larger than that of the central optical zone, this being reasonably based upon what is disclosed in Figure 1. The lens thickness will inherently remain substantially constant along a series of isolines running from side to side of the lens, this being reasonably based upon the side to side symmetry of the lens (Figure 1). Bronstein further discloses the thickness in the peripheral zone decreasing significantly when approaching the top of the lens (Figure 1); and that the lens can be bifocal (column 3, lines 18-20). The anterior surface will inherently be continuous in first or second derivative, this being reasonably based upon the smooth change in curvature of this surface as disclosed (Figure 1). The transitional non-optical zone or peripheral zone can inherently be considered as comprising a series of portions in contact with each other and therefore can inherently be considered as comprising a series of "surface patches". Since different bifocal lenses will inherently have different optical powers, depending on the optical prescription of the user, then a number of such lenses

can be considered as a "series of contact lenses having a series of different multifocal properties".

Claims 1-2, 13-14, 16-17, 19, 26-27, 29-31 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Butterfield patent number 2,544,246.

Butterfield reads on these claims by disclosing the limitations therein including the following: a contact lens comprising a posterior and anterior surface (column 1, lines 1-4, Figures 1-2); the anterior surface including a central optical zone (Figure 2, "13", column 2, line 31, column 3, line 7); a transitional non-optical zone extending from the central optical zone and surrounding the central optical zone (Figures 1 and 2, "16", indicated by "1 mm", column 3, lines 7-16); a peripheral zone surrounding the transitional non-optical zone (Figures 1-2, that portion of "14" extending from portion "16" until it flattens out near the end of the lens as shown in Figure 1); an edge zone circumscribing and tangent to the peripheral zone (Figure 1, the outermost portion of "14" where it flattens out and has an even thickness). The lens will inherently have a vertical and horizontal meridian since these are defined in the specification in terms of imaginary lines on the contact lens (page 6 of the specification). Butterfield further discloses the transitional non-optical zone has a surface which provides a continuous transition from the central optical zone to the peripheral optical zone (column 3, lines 7-16) to ensure that the peripheral zone, the transitional non-optical zone, and the central optical zone are tangent to each other (Figures 1-2, column 3, lines 7-16); the peripheral zone having a thickness profile characterized by a mirror symmetry with respect to a plane cutting through the vertical meridian (Figure 1); a substantially constant thickness

in a region around the horizontal meridian (Figure 1 i.e. a substantially constant thickness near the center of the lens); and a thickness which decreases progressively from the horizontal meridian upward to the bottom edge of the edge zone (Figure 1 which disclose the thickness substantially constant at the lens center and progressively decreasing upward). The area of the peripheral zone is inherently equal to or larger than that of the central optical zone, this being reasonably based upon what is disclosed in Figure 1). The lens thickness will inherently remain substantially constant along a series of isolines running from side to side of the lens, this being reasonably based upon the side to side symmetry of the lens (Figure 1). Butterfield further discloses the thickness in the peripheral zone decreasing significantly when approaching the top of the lens (Figure 1); the edge zone as circular and, in combination with the posterior surface, provides a substantially uniform thickness around the edge of the lens (Figure 1, the outermost portion of "14" where it flattens out and has an even thickness). The transitional non-optical zone or peripheral zone can inherently be considered as comprising a series of portions in contact with each other and therefore can inherently be considered as comprising a series of "surface patches".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bronstein or Butterfield.

With respect to claims 20, Bronstein and Butterfield disclose as is set forth above but do not specifically disclose the lens formed by a numerically controlled lathe or mold. However, the examiner takes Judicial Notice that it is well known in the art of contact lenses for such lenses to be formed by either lathing or molding for the purpose of providing an economical and efficient way of producing high quality contact lenses. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the contact lens of either Bronstein or Butterfield formed by either lathing or molding since it is well known in the art of contact lenses for such lenses to be formed by either lathing or molding for the purpose of providing an economical and efficient way of producing high quality contact lenses.

Claims 32, 35, 41-42, 44, and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butterfield.

With respect to claims 32, 35, 41-42, 44, and 46-47, Butterfield discloses as is set forth above but does not specifically disclose the contact lens as providing cylinder power correction or multifocal power correction. However, the examiner takes Judicial Notice that it is well known in the art of contact lenses for such lenses to have a toric eyeside surface i.e. cylinder power correction for the purpose of providing astigmatic correction or to have multifocal power correction for the purpose of correcting both a user's near and distance optical viewing. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the contact

lens of Butterfield as having either cylinder power correction or multifocal power correction since it is well known in the art of contact lenses for such lenses to have a toric eyeside surface i.e. cylinder power correction for the purpose of providing astigmatic correction or to have multifocal power correction for the purpose of correcting both a user's near and distance optical viewing. Since different bifocal lenses will inherently have different optical powers, depending on the optical prescription of the user, then a number of such lenses can be considered as a "series of contact lenses having a series of different multifocal properties".

***Allowable Subject Matter***

Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 3-12, 21-25, 28, 34, 36-40 and 43, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims (and overcoming the double patenting rejections and claim objections above).

The following is a statement of reasons for the indication of allowable subject matter: none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to claims 3-12, 21-25, and 36-40, none of the prior art either alone or in combination disclose or teach of the claimed contact lens, method of producing a contact lens, or series of contact lenses, specifically including, as the

distinguishing feature in combination with the other limitations, the claimed thickness profile progressively increasing and decreasing as claimed. Specifically, with reference to claims 15, 28 and 43, none of the prior art either alone or in combination disclose or teach of the claimed contact lens, method of producing a contact lens, or series of contact lenses, specifically including, as the distinguishing feature in combination with the other limitations, the claimed isolines as arcs above and below different from each other and mimicking arcs of the eyelid as claimed. Specifically, with reference to claim 34 none of the prior art either alone or in combination disclose or teach of the claimed contact lens, method of producing a contact lens, or series of contact lenses, specifically including, as the distinguishing features in combination with the other limitations, the claimed edge zone as circular and in combination with the posterior surface providing a substantially uniform thickness around the edge and the anterior surface as continuous in first derivative or second derivative or both from center to edge.

#### ***Response to Arguments***

Applicant's arguments with respect to the above rejected claims have been considered but are moot in view of the new ground(s) of rejection set forth above.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Conclusion***

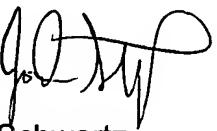
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:30 to 4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit: 2873

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Jordan M. Schwartz  
Primary Examiner  
Art Unit 2873  
July 28, 2005